

REMARKS

The application has been amended and is believed to be in condition for allowance.

The amendment is being filed as part of an RCE application. As discussed with Examiner Luks on May 29, 2007, the present amendments necessitate filing the RCE, and further that should the case not be allowed, a non-final Official Action will be issued.

The subject matter of claims 21 has been incorporated into claim 12, claims 20-21 being cancelled.

New claims 31-32 are based on recitations removing from claim 12.

Claim 33 is based on prior claims and the specification as filed, e.g., page 4 last two paragraphs. Claim 23 has been likewise amended.

Claim 24 has been amended to incorporate claim 30, claim 30 being cancelled.

Claims 17-18 have been amended, responsive to the antecedent basis objection, to recite the components being on the outside as illustrated by Figure 2.

Claims 12, 15, 16, 19-27 and 30 were rejected as obvious over AMBROSE 4,852,177 in view of LEVIN 6,144,750.

Claims 17, 18, 28 and 29 were rejected in further view of JUNEAU 6,228,020.

The Official Action on page 3, beginning with line 10 acknowledges that AMBROSE fails to teach:

- the cross section of said standard part being symmetrically oval;
- the standard part being made of rigid plastic;
- an injection molded means for removing the hearing aid from the auditory canal;
- the removing means being a pull rod connected to the standard part housing; and
- the standard part having an outer end face provided with a sound aperture for said microphone, the sound aperture being located in the center of the outer end face.

Applicant does not agree that LEVIN teaches the missing features. However, the Official Action offered LEVIN for disclosing the cross section of said standard part being mirror symmetrically oval; the standard part being made of rigid plastic; a means for removing the hearing aid from the auditory canal; the removing means being a pull rod connected to the standard part housing; and the standard part having an outer end face provided with a sound aperture for said microphone, the sound aperture being located in the center of the outer end face.

This combination would fail to disclose switching means on the outside and connector means or adjustment facility on the outside, the sound aperture between the switch and adjusting

facility. JUNEAU was offered for teaching or suggesting these features.

Although LEVIN was offered for the cross section of said standard part being mirror symmetrically oval, etc., there is no discussion in the Official Action as to why or how one of skill would adapt the features of LEVIN into the hearing aid of AMBROSE. When one considers these questions, it becomes clear that LEVIN does not motivate, teach, or suggest the changes necessary to modify AMBROSE.

The Official Action does not follow the direction of *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18, which set an objective analysis for applying section 103: "[T]he scope and content of the prior art are ... determined; differences between the prior art and the claims at issue are ... ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented."

The Official Action has stopped short and has only determined the scope and content of the prior art are and then identified the differences between the prior art and the claims at issue. The Official Action has found other prior art with the missing features but has not considered, or at least explained, why

those features would obviously cause one of skill to modify the primary prior art reference.

There is no showing, of record, that the needed modifications were within the grasp of a person of ordinary skill in the art or that the benefit of doing so would be obvious. Note that the latest guidance from the Supreme Court (*KSR International Co. v. Teleflex Inc.* Slip Opinion No. 04-1350 Decided April 30, 2007) provides that the teaching, suggestion, motivation test captures the concepts that an invention composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art, and notes the importance to identify the reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does. See the Syllabus which notes that inventions usually rely upon building blocks long since uncovered, and claimed discoveries almost necessarily will be combinations of what, in some sense, is already known.

The Federal Circuit emphasized in July, 1998 that "[m]ost, if not all, inventions are combinations and mostly of old elements." *In re Rouffett*, 47 USPQ 2d 1453, 1457 citing to *Richdel, Inc. v. Sunspool Corp.*, 219 USPQ 8, 12 (Fed. Cir. 1983). The Federal Circuit continued by noting that "rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a

blue print for piecing together elements in the prior art to defeat the patentability of the claimed invention."

This is consistent with the Federal Circuit requiring that in order to prevent the use of hindsight, the Official Action must "show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." (*In re Rouffett* at 1458). The present rejection fails to meet this requirement. Likewise, as stated by MPEP §706.02(j), to establish a *prima facie* case of obviousness the Official Action must first, consider the relevant teachings of the prior art, and after determining the differences between the pending claim and the prior art teachings, second, propose modifications of the prior art necessary to arrive at the claimed subject matter, explaining the motivation for combining the particular references and making the proposed modifications to those references. Thus, there must be motivation to modify the references and a teaching or suggestion of all the claim recitations.

The present rejection over AMBROSE and LEVIN fails to satisfy these requirements.

As a result of the present invention, in particular the cross section of said standard part being symmetrically oval, a 180 degree rotation make no cosmetic or acoustic difference between one ear and the other ear, while technically the same hearing aid

standard part is still being used on the left and on the right (see paragraph [0009] and [0010]). Due to the central position of the sound aperture, the aperture will always have the same position relative to the pinna of the person concerned. Due to the symmetric properties of the standard part, the dedicated part always fits with the standard part, no matter for what ear it is used. The dedicated part of the hearing aid is adapted to the auditory canal of the specific person using the hearing aid. As a consequence, a good fit is obtained, despite the fact that the same standard part is used in different ears.

LEVIN Figures 2-24 show a variety of shapes for front faces of hearing aids. LEVIN teaches to adapt the shape of the front face to the inner ear of specific person who will be using the hearing aid. Further, in none of the figures is the front face symmetrically shaped.

There is no teaching or suggestion that the standard part having a cross section being symmetrically oval. Further, there is no teaching that the cross section of an outer boundary of the end face of the standard part is mirror symmetrical in outside end view.

Without any such teaching, there is no basis for concluding that the claimed invention is obvious.

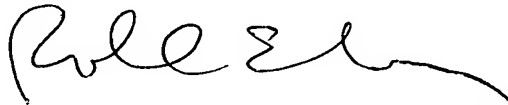
Accordingly, the presently pending claims are believed to be non-obvious over the prior art. Reconsideration and allowance of these claims are therefore solicited.

Should there be any matters that need to be resolved in the present application; the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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